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EXAMINER	
MURPHY, DILLON J	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,230	OZAKI, HIROSHI	
	Examiner	Art Unit	
	Dillon J. Murphy	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 December 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/14/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: #301, #303, and #306, all mentioned on page 11 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 29-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

Accordingly, claims 30-41, which depend from claim 29, are also rejected under 35 U.S.C 101 because they inherit the deficiencies of claim 29.

Claim 42 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure per se or a computer program per se, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program per se, which does not

mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

Storage medium as cited in claim 42 is directed to a non-statutory subject matter, for example, storage medium can be interpreted as a "paper media" containing printed computer program instructions. The examiner recommends the applicants replace "storage medium" with "computer readable medium comprising computer-executable instructions" to comply with 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 11, 12, 14, 15, 23, 25, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hicks et al. (US 5,481,353), hereafter referred to as Hicks.

Regarding claim 1, Hicks teaches an information processing apparatus (Hicks, figure 7, information processing system, IPS, #12) for generating print data to be printed by a printer, the information processing apparatus comprising:

A setting unit adapted to set a print property specifying a manner in which the print data is to be printed (Hicks, col 4, ln 10-15, user interface, UI, communicates with IPS to specify copy and print parameters);

A special-printing-mode specification unit adapted to specify a special printing mode (Hicks, figure 2, special mode is specified in the User Interface apparatus by selecting "transparencies" icon in user interface, entering special printing mode);

And print property information generator adapted to generate print property information such that when the special printing mode is not selected, the print property information generator generates, in accordance with the setting made by the setting means, first print property information specifying a manner in which printing is performed on a first recording sheet (Hicks, col 7, ln 4-6, and figure 2, basic features of printing, when presentation mode is not selected, can be performed according to the typical operation of the copier/printer), whereas when the special printing mode is selected, the print property information generator generates, in addition to the first print property information, second print property information specifying a manner in which printing is performed on a second recording sheet (Hicks, figure 2, when transparency icon is selected, new window is brought up (figure 3) to print second print property information on a second sheet as well as printing the first print data on a first sheet).

Regarding claim 9, which depends from claim 1, Hicks further teaches an information processing apparatus wherein the first recording sheet and the second recording sheet are of the same sheet type (Hicks, col 8, ln 9-18, apparatus allows user to select an option which prints presentation sets on opaque sheets, while the presentation document is created as a multi-page poster, printed on the same opaque sheet type).

Regarding claim 11, which depends from claim 1, Hicks further teaches an information processing apparatus further comprising a job generator adapted to generate a print job interpretable by a printer, from the print data and the print property information generated by the print property information generator (Hicks, figure 7, Information Processing System IPS, #12, and Raster Output Scanner ROS, #16, generate jobs for printer #18).

Regarding claim 12, which depends from claim 11, Hicks further teaches an information processing apparatus wherein the job generator generates a first print job on the basis of the first print property information and the print data and generates a second print job on the basis of the second print property information and the print data (Hicks, col 7, ln 42-67, a first print job such as "dividers," a "master set," or a "handout set" is generated on the basis of the first print property information, which is independent from the second print job, "transparencies," generated on the basis of the second print property information. In this case, print property information may include color configurations, layout, number of pages, and media type).

Regarding claim 14, which depends from claim 1, Hicks further teaches an information processing apparatus wherein the special printing mode is a presentation mode, the first print property information includes print property information describing a property associated with a printing process for creating a copy for a distribution, and the second print property information is print property information describing a property associated with a printing process for creating a copy for a presentation (Hicks, col 6, ln 52-61, information processing apparatus generates print data wherein transparencies

are printed to be used for presentation and handouts are printed to be used for distribution. See also col 3, ln 7-15 for explanation of presentation and distribution documents).

Regarding claim 15, the structural elements of apparatus claim 1 perform all of the method claim 15. Therefore, method claim 15 is rejected for the same reasons as stated above in the rejection of claim 1.

Regarding claim 23, which depends from claim 15, the structural elements of apparatus claim 9 perform all of the method claim 23. Therefore, method claim 23 is rejected for the same reasons as stated above in the rejection of claim 9.

Regarding claim 25, which depends from claim 15, the structural elements of apparatus claim 11 perform all of the method claim 25. Therefore, method claim 25 is rejected for the same reasons as stated above in the rejection of claim 11.

Regarding claim 26, which depends from claim 25, the structural elements of apparatus claim 12 perform all of the method claim 26. Therefore, method claim 26 is rejected for the same reasons as stated above in the rejection of claim 12.

Regarding claim 28, which depends from claim 15, the structural elements of apparatus claim 14 perform all of the method claim 28. Therefore, method claim 28 is rejected for the same reasons as stated above in the rejection of claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-8, 10, 13, 16-22, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks et al. (US 5,481,353) and Han (US 2003/0103237), hereafter referred to as Hicks and Han.

Regarding claim 2, which depends from claim 1, Hicks teaches an information processing apparatus comprising a setting unit, a special-print-mode unit, and a print property information generator, as explained in the rejection of claim 1 above. Although Hicks teaches a print property information generator, the references does not expressly disclose a print property information generator that automatically sets a predetermined print property to a predetermined property value. Han, however, teaches an information processing apparatus wherein the print property information generator automatically sets a predetermined print property to a predetermined property value (Han, information processing unit is printing unit #220 in figure 3, wherein the data is generated and printed according to a predetermined format, paragraph 30).

Hicks and Han are combinable because they are from the similar problem solving area of printing presentation transparencies concurrently with distribution papers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the information processing apparatus of Han that automatically sets a predetermined print property to a predetermined property value with the information processing apparatus of Hicks that comprises a setting unit, a special-print-mode unit, and a print property information generator. The motivation for combining the automatic

print property generator with the aforementioned print property apparatus would have been to obtain the results more quickly and with simple operation by the user when printing on transparency film, as well as increasing work efficiency and user convenience by allowing for the possibility to print on normal paper at the same time (Han, paragraph #40). Therefore, it would have been obvious to combine Han with Hicks to obtain the invention as specified in claim 2.

Regarding claim 3, which depends from claim 2, the combination of Hicks and Han further teaches an information processing apparatus wherein the predetermined print property is a property associated with a finishing process of a recording sheet (Hicks, col 10, ln 12-27, different media go to different trays, wherein the various trays have different associated finishing processes, as determined by associated print properties).

Regarding claims 4, 5, and 6, which individually depend from claim 3, the combination of Hicks and Han further teaches an information processing apparatus wherein the property associated with the finishing process is set such that binding of a plurality of recording sheets is not performed by stapling the recording sheets, the property is set such that a folding process for folding a recording sheet is not performed, and the property is set such that a punching process for punching a hole in a recording sheet is not performed (Hicks, col 10, ln 62-63, finishing properties are evidenced by state of final outputted images on sheets, wherein the second recording sheets are not stapled, folded, or finished with holes punched in the sheet).

Regarding claim 7, which depends from claim 3, the combination of Hicks and Han further teaches an information processing apparatus wherein the predetermined print property is a property associated with a layout in which data is printed on a recording sheet (Hicks, based upon copy mode and various options selected in figure 3, predetermined layouts are printed on recording sheets, as seen in figure 4 as the outputs to the selected decisions of the options in figure 3. For example, selecting the "Dividers" option in figure 3 causes the image data to be printed in the "Dividers" format 1D, 2D, 3D, seen in figure 4).

Regarding claim 8, which depends from claim 7, the combination of Hicks and Han further teaches an information processing apparatus wherein the property associated with layout is set such that a plurality of logical pages are not printed on one physical sheet (Hicks, figure 4, the presentation print data (Transparencies, 1T, 2T, 3T), analogous to the second print property information, is shown to only include one logical sheet per physical page for presentation).

Regarding claim 10, which depends from claim 1, the combination of Hicks and Han further teaches an information processing apparatus wherein the first recording sheet is opaque and the second recording sheet is transparent (Han, paragraph 14, printing apparatus prints presentation data on both transparency films and normal paper with one printing command).

Regarding claim 13, which depends from claim 11, the combination of Hicks and Han further teaches an information processing apparatus wherein the job generator generates a single print job including, in a combined form, the first print job and the

second print job (Han, paragraph 14, printing apparatus prints presentation data on both transparency films and normal paper with one printing command).

Regarding claim 16, which depends from claim 15, the structural elements of apparatus claim 2 perform all of the method claim 16. Therefore, method claim 16 is rejected for the same reasons as stated above in the rejection of claim 2.

Regarding claim 17, which depends from claim 16, the structural elements of apparatus claim 3 perform all of the method claim 17. Therefore, method claim 17 is rejected for the same reasons as stated above in the rejection of claim 3.

Regarding claim 18, which depends from claim 17, the structural elements of apparatus claim 4 perform all of the method claim 18. Therefore, method claim 18 is rejected for the same reasons as stated above in the rejection of claim 4.

Regarding claim 19, which depends from claim 17, the structural elements of apparatus claim 5 perform all of the method claim 19. Therefore, method claim 19 is rejected for the same reasons as stated above in the rejection of claim 5.

Regarding claim 20, which depends from claim 17, the structural elements of apparatus claim 6 perform all of the method claim 20. Therefore, method claim 20 is rejected for the same reasons as stated above in the rejection of claim 6.

Regarding claim 21, which depends from claim 17, the structural elements of apparatus claim 7 perform all of the method claim 21. Therefore, method claim 21 is rejected for the same reasons as stated above in the rejection of claim 7.

Regarding claim 22, which depends from claim 21, the structural elements of apparatus claim 8 perform all of the method claim 22. Therefore, method claim 22 is rejected for the same reasons as stated above in the rejection of claim 8.

Regarding claim 24, which depends from claim 15, the structural elements of apparatus claim 10 perform all of the method claim 24. Therefore, method claim 24 is rejected for the same reasons as stated above in the rejection of claim 10.

Regarding claim 27, which depends from claim 25, the structural elements of apparatus claim 13 perform all of the method claim 25. Therefore, method claim 27 is rejected for the same reasons as stated above in the rejection of claim 13.

Regarding claim 29, the combination of Hicks and Han further teaches a computer-readable medium (Han, figure 2, CPU #110, RAM #114, and ROM #112, wherein computer programs are stored and executed, paragraph #27) comprising computer executable instructions wherein the instructions are by an information processing apparatus (Hicks, figure 7, information processing system, IPS, #12) to generate print data to be printed by a printer, the data processing program comprising:

A setting step for setting a print property specifying a manner in which the print data is to be printed (Hicks, col 4, ln 10-15, user interface, UI, communicates with IPS to specify copy and print parameters);

A special-printing-mode specifying step for specifying a special printing mode (Hicks, figure 2, special mode is specified by selecting "transparencies" icon in user interface, entering special printing mode);

And a print property information generating step for generating print property information such that when the special printing mode is not selected, first print property information specifying a manner in which printing is performed on a first recording sheet is generated in accordance with the setting made in the setting step (Hicks, col 7, ln 4-6, and figure 2, basic features, when presentation mode is not selected, can be performed according to the typical operation of the copier/printer), whereas when the special printing mode is selected, in addition to the first print property information, second print property information specifying a manner in which printing is performed on a second recording sheet (Hicks, figure 2, when transparency icon is selected, new window is brought up (figure 3) to print second print property information on a second sheet) is generated such that a predetermined item of the print property is set to a predetermined property value (Han, information processing unit is printing unit #220 in figure 3, wherein the data is generated and printed according to a predetermined format, paragraph 30).

Regarding claim 30, which depends from claim 29, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions further comprising a step for automatically setting a predetermined print property to a predetermined property value when the second print property information is generated (Han, information processing unit is printing unit #220 in figure 3, wherein the data is generated and printed according to a predetermined format).

Regarding claim 31, which depends from claim 30, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the predetermined property value is a property associated with a

finishing process of a recording sheet (Hicks, col 10, ln 12-27, different media go to different trays, wherein the various trays have different associated finishing processes, as determined by associated print properties).

Regarding claim 32, 33, and 34, which independently depend from claim 31, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the property associated with the finishing process is set such that binding of a plurality of recording sheets is not performed by stapling the recording sheets, the property associated with the finishing process is set such that a folding process for folding a recording sheet is not performed, and the property associated with the finishing process is set such that a punching process for punching a hole in a recording sheet is not performed (Hicks, col 10, ln 62-63, finishing properties are evidenced by state of final outputted images on sheets, wherein the second recording sheets are not stapled, folded, or finished with holes punched in the sheet).

Regarding claim 35, which depends from claim 30, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the predetermined print property is a property associated with a layout in which data is printed on a recording sheet (Hicks, based upon copy mode and various options selected in figure 3, predetermined layouts are printed on recording sheets, as seen in figure 4 as the outputs to the selected decisions of the options in figure 3. For example, selecting the "Dividers" option in figure 3 causes the image data to be printed in the "Dividers" format 1D, 2D, 3D, seen in figure 4).

Regarding claim 36, which depends from claim 35, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the property associated with layout is set such that a plurality of logical pages are not printed on one physical sheet (Hicks, figure 4, the presentation print data (Transparencies, 1T, 2T, 3T), analogous to the second print property information, is shown to only include one logical sheet per physical page for presentation).

Regarding claim 37, which depends from claim 29, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the first recording sheet and the second recording sheet are of the same sheet type (Hicks, col 8, ln 9-18, apparatus allows user to select an option which prints presentation sets on opaque sheets, while the presentation document is created as a multi-page poster, printed on the same opaque sheet type).

Regarding claim 38, which depends from claim 29, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the first recording sheet is opaque and the second recording sheet is transparent (Han, paragraph 14, printing apparatus prints presentation data on both transparency films and normal paper with one printing command).

Regarding claim 39, which depends from claim 29, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions further comprising: a job generating step for generating a print job interpretable by a printer, from the print data and the print property information

generated in the print property information generating step (Hicks, figure 7, Information Processing System IPS, #12, and Raster Output Scanner ROS, #16, generate jobs for printer #18).

Regarding claim 40, which depends from claim 39, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the job generating step generates a first print job on the basis of the first print property information and the print data and generates a second print job on the basis of the second print property information and the print data (Hicks, col 7, ln 42-67, a first print job such as "dividers," a "master set," or a "handout set" is generated on the basis of the first print property information, which is independent from the second print job, "transparencies," generated on the basis of the second print property information. In this case, print property information may include color configurations, layout, number of pages, and media type).

Regarding claim 41, which depends from claim 39, the combination of Hicks and Han further teaches a computer-readable medium comprising computer-executable instructions wherein the job generating step generates a single print job including the first print job and the second print job (Han, paragraph 14, printing apparatus prints presentation data on both transparency films and normal paper with one printing command).

Regarding claim 42, the combination of Hicks and Han further teaches a computer-readable medium (Han, figure 2, CPU #110, RAM #114, and ROM #112, wherein computer programs are stored and executed, paragraph #27) comprising

computer executable instructions wherein the instructions are by an information processing apparatus (Hicks, figure 7, Information Processing System, IPS, #12) to generate print data to be printed by a printer, the data processing program comprising:

A setting step for setting a print property specifying a manner in which the print data is to be printed (Hicks, col 4, ln 10-15, user interface, UI, communicates with IPS to specify copy and print parameters);

A special-printing-mode specifying step for specifying a special printing mode (Hicks, figure 2, special mode is specified by selecting "transparencies" icon in user interface, entering special printing mode);

And a print property information generating step for generating print property information such that when the special printing mode is not selected, first print property information specifying a manner in which printing is performed on a first recording sheet is generated in accordance with the setting made in the setting step (Hicks, col 7, ln 4-6, and figure 2, basic features, when presentation mode is not selected, can be performed according to the typical operation of the copier/printer), whereas when the special printing mode is selected, in addition to the first print property information, second print property information specifying a manner in which printing is performed on a second recording sheet (Hicks, figure 2, when transparency icon is selected, new window is brought up (figure 3) to print second print property information on a second sheet) is generated such that a predetermined item of the print property is set to a predetermined property value (Han, information processing unit is printing unit #220 in figure 3, wherein the data is generated and printed according to a predetermined format).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Tabuchi et al. reference, US 5,809,392, filed February 7, 1996, is cited for teaching a printing device for simultaneously printing on a transparency medium and a normal opaque paper medium for presentation and distribution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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